

Appl. No. 10/706,104
Docket No. 9118M
Amdt. dated February 5, 2010
Reply to Office Action mailed on November 6, 2009
Customer No. 27752

REMARKS

Claim Status

Claims 18-20, 24-29, 31-32, 34 and 36 are pending in the present application. No additional claims fee is believed to be due.

Independent claims 18, 28, 32, and 34 have been amended. Support for these amendments can be found, for example, on page 11, lines 8-23 of the specification. Claim 36 has been amended. Support for this amendment can be found, for example, in the specification on page 30, example I-4.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §112, First Paragraph

The Office Action rejects claims 18-20, 24-29, 31-32, 34, and 36 under 35 USC 112, first paragraph, for failing to comply with the written description. Each independent claim has been amended to include about 7% to about 25%, by weight of the composition, of a retentive agent comprising carboxymethylcellulose and at least one selected from the group consisting of hydroxyethylcellulose, hydroxypropylmethyl cellulose, and hydroxypropylcellulose. The 7%-25% levels for the retentive agent are supported in the specification on the last line of page 7. Claim 36 has been amended so that the retentive agent consists essentially of about 3% hydroxyethylcellulose and about 6% carboxymethylcellulose, by weight of the composition, which is supported in the specification on page 30 in example I-4.

Therefore, Applicants respectfully submit that the 112 rejection be withdrawn.

Rejection Under 35 USC § 103(a) over Lawlor (US 6,706,256) in view of La Rochelle
(US 4,157,386)

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The Office Action rejects claims 18-20, 24-29, 31-32, 34, and 36 under 35 USC 103(a) as being unpatentable over Lawlor in view of La Rochelle.

To establish a *prima facie* case of obviousness under §103, the Examiner has the burden of showing, by reasoning or evidence, that: 1) there is some suggestion or motivation, either in the references themselves or in the knowledge available in the art, to modify that reference's teachings; 2) there is a reasonable expectation on the part of one of ordinary skill in the art that the modification or combination has a reasonable expectation of success; and 3) the prior art references (or references when combined) teach or suggest all the claim limitations. MPEP §2145. Applicants submit that the burden of a *prima facie* case of obviousness has not been met.

Applicants have amended each independent claim so that the oral care composition comprises from about 0.5% to about 20% of a retention modifier, selected from the group consisting of bentonites, pectin, shellac, insoluble polymers, zein, and alkyl vinyl ether-maleic acid or anhydride copolymer and salts thereof, and mixtures thereof. Lawlor and La Rochelle fail to disclose a retention modifier or any of the specific materials in the claims as amended. Therefore, because the prior art references, individually and combined, fail to teach or suggest all the claim limitations, a *prima facie* case of obviousness has not been met.

Furthermore, Applicants note that when determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Applicants respectfully contend that the present claim limitations that the composition forms an intact hydrated mass that is visible on 2 to 3 molar or premolar surfaces to greater than 7 molar or premolar surfaces for 5 minutes to 60 minutes after a human subject chews two tablets of the composition for 5 to 30 seconds, brushes his or her teeth with a manual, flat head, soft toothbrush for 30 seconds, expectorates the slurry created from the brushing, and then rinses with 10 ml of water and expectorates again is not taught or remotely suggested by the cited references. The Office Action relies on this passage in Lawlor: "In order to maximize the effects of such methods it is preferred that the compositions of the present invention are formulated such that they remain in the oral cavity for at least 10 seconds. The methods are improved the longer the composition remains in the oral cavity." (col 24, lines 36-39). Applicants

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respectfully argue that a composition retained in the mouth for “at least 10 seconds” along with a generic statement that longer is better is a far and unobvious step from the retention of a composition *for up to 60 minutes, after brushing*. As stated by the Supreme Court in *KSR*, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicants respectfully submit that a *prima facie* case of obviousness has not been made and respectfully request that the rejection be withdrawn and the claims allowed.

Conclusion

This response represents an earnest effort to place the present application in proper form. In view of the foregoing, entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claims are respectfully requested.

Respectfully submitted,

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